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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,644	12/05/2003	David A. Hill	HII 303CIP	8417

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EXAMINER

AFTERGUT, JEFF H

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 01/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/728,644

Applicant(s)

HILL, DAVID A.

Examiner

Jeff H. Aftergut

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 8-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5-3-04</u> . | 6) <input type="checkbox"/> Other: ____. |

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-7, drawn to a press, classified in class 156, subclass 580.
 - II. Claims 8-15, drawn to a method of forming a wood product, classified in class 156, subclass 311.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as one for gluing boards together in the same manner as defined by Yow wherein there assembly of pieces being joined do not have two separate glue lines which are non-parallel with one another.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
5. During a telephone conversation with Pierre Van Rysselberghe on 1-5-06 a provisional election was made without traverse to prosecute the invention of Group II,

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claims 8-15. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-7 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 8-15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,214,148.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims as presented herein include all of the steps performed by the earlier claimed invention but define the invention as a genus of the earlier presented species. As such the earlier presented species clearly covers the newly presented genus and all claims are suggested by the earlier claimed invention.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 8-11 and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Hallonquist et al in view of Yow.

Hallonquist et al suggested that it was known to form a low density particle board door assembly from a core of low density material 11 and disposing a plurality of veneers thereon which included a veneer along the edge 18 as well as a veneer along the top and bottom sides 15, 15. The reference taught that the veneers in the assembly were disposed in a press and subjected to pressure in order to adhere the veneers to the core. It should be noted that reference failed to expressly state that the press was such that it applied pressure to all sides and the top and bottom simultaneously to secure the veneers to the core, however, it was clear that one desired to attach the veneers to both the top and bottom as well as the sides of the core within a press arrangement.

Yow suggested a suitable press assembly for pressing the core of Hallonquist. The reference suggested that it was known to apply pressure to an assembly of wood pieces with a press arranged to apply pressure with a first platen which was moveable in a direction perpendicular to the first side of the core and a second platen which was moveable in a direction perpendicular to the second side of the core. The press

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operates both the pusher shoes and the top platen simultaneously in order to press the wood pieces together into an assembly. Such a pressing arrangement would have been useful for simultaneous pressing of the sides of the veneer and the top and bottom of the arrangement of Hallonquist et al as it would have allowed one to simultaneously attach the top and bottom veneers with the side veneers in the operation of making a laminated veneer door assembly. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the press of Yow in the manufacture of the door assembly of Hallonquist et al wherein the use of the press ensured that the veneers were joined to the core in a single pressing operation.

With regard to claim 9, note that Hallonquist suggested that one apply glue between the core and the veneer. Regarding claim 10, note that the exterior sheets in Hallonquist were veneers. Regarding claim 11, note that the adhesive employed was a thermosetting adhesive material. Regarding claim 13, note that the sides and the top and/or bottom are perpendicular to one another and thus the pressing would have been in perpendicular direction.

10. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as set forth above in paragraph 9 further taken with Lewis '592 and further taken with U.K. 5274.

The references as set forth above formed the veneer assembly from separate pieces of veneer material, however they failed to teach that one skilled in the art would have employed a hinged veneer assembly. However, it was known at the time the invention was made to employ a single sheet of material for the veneer wherein the

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single sheet of material was bent about the core in order to decorate the same on both the top or bottom and at least along one of the sides as evidenced by Lewis '592.

Applicant is more specifically referred to Figures 7-11 of Lewis and the description therein. It would have been within the purview of the ordinary artisan to employ a single sheet of material for the veneer in the operation of covering the top and bottom and sides as suggested by Lewis '592. The reference to Lewis '592 does not provide a hinge to facilitate the folding operation along the edges, however to make the sheet of veneer more easily bent at the corners to facilitate the folding operation, the reference to U.K. '274 is cited. U.K. '274 suggested that it was known at the time the invention was made to employ a grooving operation to facilitate the bending of a veneer in the manufacture of a box. One skilled in the art would have understood that as such the grooved veneer provided a hinge between portions of the veneer to facilitate the bending of the same. In order to render the bending operation more efficient and easily performed, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the techniques of U.K. 5274 to form a grooved veneer suitable for disposing about a core and bent around the same as taught was performed with a single sheet of material as suggested by Lewis '592 in the process of making a veneered core of material as set forth above in paragraph 9.

11. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as set forth above in paragraph 9 further taken with the state of the prior art as exemplified by the article submitted in the IDS entitled "Presses and Jigs" as well as the product description of the Firestone Airstroke actuators.

While the references as set forth above suggested that one apply pressure to the assembly, the failed to expressly state that the pressure was approximately 10,000 pounds of pressure and that the pressing step was carried out with the use of air powered actuators. It should be noted that Yow suggested that one skilled in the art suggested the use of hydraulic cylinders for pressing the assembly together. The artisan was well aware of the use of air cylinders for pressing the assembly and one skilled in the art would have understood such to have been an art recognized equivalent as Firestone Airstroke actuators were well known in the art for actuators. Additionally, while the reference to Hallonquist et al suggested a maximum pressure of 50 psi, this was because the core being pressed was a low density core material. As evidenced by "Presses and Jigs" it was known to apply greater amounts of pressure as a function of the core material being pressed. Obviously with a more dense and structural core one skilled in the art would have understood that greater pressure would have been suitable for such processing. Particularly in light of "presses and Jigs" where the reference clearly envisioned utilizing different pressures with different core materials. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the techniques of the state of the prior art wherein one employed air cylinders rather than hydraulic cylinders for the press as well as employed a pressure up to 10,000 pounds upon the assembly (note that applicant's own disclosure employed particleboard core materials as the reference to Hallonquist et al does) in the process of making a veneered panel as set forth above in paragraph 9.

Specification

12. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: There is no disclosure as to the use of a hinged assembly as defined in claim 12 nor is there any disclosure as originally presented of employing a pressure of 10,000 pounds of pressure.

Claim Rejections - 35 USC § 112

13. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

14. Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim recites a hinge structure for the assembly of the two sheets of material, however the original disclosure makes no mention of a hinge arrangement for two separate sheets of material. Rather the original disclosure appears to describe a single sheet of veneer which was grooved in order to enable the single sheet of veneer to be bent about the groove. It is not clear what was meant by a "hinge" as defined in the claim (i.e. whether there are two separate sheets which are joined by a hinge structure or not). The original disclosure does not provide

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an adequate written description as to what was meant by "hinge structure". For purposes of rejection (above) in comparison with the prior art, it was assumed that the "hinge" structure was a grooved veneer, however applicant is advised that if this in fact the case then the claim should be rewritten in independent form as it would be taking away limitations from the independent claim which requires two sheets of veneer (rather than a single sheet of veneer with grooves therein).

15. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

16. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A hinge structure as claimed is not clear and concise as to what was described in the original disclosure. It would appear that applicant intends the claim to cover a single veneer with a groove therein to facilitate bending of the veneer. However, the claim depends upon a claim which requires two separate veneers therein and the original disclosure failed to recite how a hinge assembly was formed with the same. It appears that the claim should be rewritten into independent form and recites only a single veneer with the groove therein (which forms the hinge in the assembly).

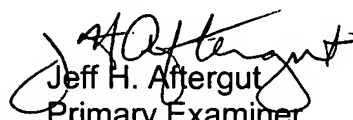
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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff H. Aftergut whose telephone number is 571-272-1212. The examiner can normally be reached on Monday-Friday 7:15-345 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jeff H. Aftergut
Primary Examiner
Art Unit 1733

JHA
January 9, 2006